

Serial No.: 09/344,526
Filed: June 24, 1999

REMARKS

Claims 16-20 and 36-59 are pending. Claims 16-20 are allowed. Claims 36 and 54 are amended. Support is found in the bridging paragraph of p. 18 and 19 and the first full paragraph of p. 19 as filed. Claims 45 and 55 are amended to be in independent form. Support is found in the claims as filed and at pp 10-13. Claim 47, 52 and 58 are amended to correct typographical errors. Claim 59 is amended to properly depend from claim 58. New claims 60-65 are submitted and find support in the claims as filed. No new matter is introduced by way of this amendment. In light of the amendments and comments submitted herein, Applicants submit that the claims are in allowable form. If, however, there remain any issues that the Examiner feels can be resolved by way of a teleconference, Applicants ask that the Examiner phone the undersigned attorney at 415-544-7085.

Applicants draw the Examiner's attention to the Supplemental Information Disclosure Statement submitted herewith and request an indication that the references cited therein have been considered.

Response to Rejections

Title

The Examiner suggests that the title is not descriptive. In response Applicants have amended the title to correspond with the pending claims. Applicants respectfully request the Examiner to withdraw this rejection.

New Matter

Claims 36-51 and 54-57 are rejected under 35 U.S.C. 112, first paragraph for lack of written description. The Examiner suggests that the claim limitation "do not comprise a label" does not find support in the application as filed and therefore is considered New Matter. Applicants respectfully traverse.

Initially, Applicants submit that the term "do not comprise a label" does not constitute new matter. However, in an effort to expedite prosecution of this case, Applicants have amended

the claims 36 and 54 to replace this phrase with the phrase “do not comprise an optical tag”. As noted above, support for “optical tag” is found in the bridging paragraph of p. 18 and 19 and the first full paragraph of p. 19. Here, the present invention is described and it is noted that the present invention does not rely solely on the use of optical properties. Such optical properties were described in the preceding paragraph and include optical signatures or optical tags. Thus, Applicants submit that the specification provides an adequate written description of that which is claimed such that one of ordinary skill in the art would know that Applicants had possession of the invention at the time the application was filed. Applicants respectfully request the Examiner to withdraw this rejection.

Vagueness and Indefiniteness

Claim 59 is rejected under 35 U.S.C. 112, second paragraph because it depends from claim 60, which was not pending in this case prior to the instant amendment. In response, Applicants have amended claim 59 to correct this typographical error. Claim 59 now properly depends from claim 58. Applicants respectfully request the Examiner to withdraw this rejection.

Improper Dependence

Claims 45-51 and 55-57 are objected to under 37 CFR § 1.75(c) as being of improper dependent form for allegedly failing to further limit the subject matter of a previous claim. Applicants respectfully traverse. Moreover, Applicants submit that the rejection is moot because claims 45 and 55 have been rewritten in independent form, as suggested by the Examiner. As such, Applicants submit that the claims are of proper dependent form. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

Provisional Obviousness-type Double Patenting

Claims 36-59 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-39 of co-pending Application 09/748,706 in view of Walt (6,023,540).

Applicants note that they will consider filing a terminal disclaimer if necessary and appropriate when there is an indication of otherwise allowable subject matter.

Serial No.: 09/344,526
Filed: June 24, 1999

Informalities

The Examiner noted that claims 52 and 58 contain internal periods as subpart designations and thus objected to the disclosure. In response, Applicants have amended the claims to delete any internal periods. Applicants respectfully request the Examiner to withdraw this objection.

CONCLUSION

Applicants submit that the claims are in condition for allowance and early notification to this effect is solicited. The Examiner is invited to contact the undersigned at (415) 781-1989 if any issues remain.

Respectfully submitted,
DORSEY & WHITNEY LLP



David C. Foster, Reg. No. 44,685, for
Robin M. Silva, Reg. No. 38,304

Customer No. 32940
Four Embarcadero Center
Suite 3400
San Francisco, CA 94111-4187
Telephone: (415) 781-1989

SF-1120593